UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 08/942,810 | 10/02/97 | WATTERSON | S 2727.1US |

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| EXAMINER | |
|---|---|
| RICHMAN,G | |
| **ART UNIT** | **PAPER NUMBER** |
| 3733 | |

**DATE MAILED:** 12/04/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

| Office Action Summary | Application No. 08/942,810 | Applicant(s) Watterson et al |
|---|---|---|
| | Examiner Glenn Richman | Group Art Unit 3733 |

☒ Responsive to communication(s) filed on *11/16/98* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) *1-20* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-20* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---*

*Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-20 of U. S. Patent No. 5,674,453 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: All the claims of the instant application are directed to claimed subject mater previously claimed in U.S. Patent No. 5,674,453.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. Claims 4-14 and 15-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-13 and 14-19 of U.S. Patent No.5,674,453 . Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims are mere changes in wording and not changes in subject matter claimed.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 16, and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the HouseFit foldable treadmill, hereinafter referred to as "HouseFit", disclosed on page 197 of the 1993 Sporting Goods Taiwan Buyer's Guide.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over HouseFit in view of Lynch.

As to claim 15, HouseFit fails to disclose pivotally mounted rigid left and right handles. Lynch teaches the use of a left rigid handle pivotally connected to the left upright member of a treadmill and positioned for grasping by a user positioned on the endless belt of the treadmill and a right rigid handle pivotally connected to the right upright member of the treadmill and positioned for grasping by a user positioned on the endless belt to allow the user to perform strength training exercise while exercising on the treadmill. It would have been obvious to one of ordinary skill in the art to modify the treadmill disclosed by HouseFit to include a left rigid handle pivotally connected to the left upright member of a treadmill and positioned for grasping by a user positioned on the endless belt of the treadmill and a right rigid handle pivotally connected to the right upright member of the treadmill and positioned for grasping by a user positioned on the endless belt to allow the user to perform strength training exercise while exercising on the treadmill in view of the teaching of Lynch.

As to claim 20, as discussed supra it would have been obvious to one of ordinary skill in the art to modify the treadmill disclosed by HouseFit to use the handles taught by Lynch.

8. Claim 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over HouseFit in view of the LC-611F or LC-611FM, 11-Function Exercisers disclosed on page 2 of the 1995 Sports Goods Taiwan Buyers's Guide, hereinafter referred to as"LC-611".

As to claim 18, HouseFit discloses simple left and right handles. LC-611 make obvious the use of left and right handles each having a second portion connected to the first portion and extending downwardly toward the feet means.

As to claim 19, LC-611 further make obvious left and right handles each having a third portion connected to the second portion to extend toward said left and right upright member, respectively.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn Richman whose telephone number is (703) 308-3170.

gr

December 2, 1998

**Glenn Richman**

**Primary Examiner**

**AU 3733**